

REMARKS

The applicant provides the following remarks which address each concern raised by the office in the non-final communication mailed February 21, 2007.

1. Election/Restriction. The applicant acknowledges that the election is treated as an election without traverse. The invention of Group I (claims 1-13) is being examined.
2. Cancellation of Claims. The applicant cancels claims 11 and 14-24 without prejudice and does not waive any right to have claims 14-24 examined as part of a continuation, division, continuation-in-part or other continuing application.
3. Information Disclosure Statement. The applicant has reviewed the reference numbers cited in the Information Disclosure Statement and believes that these were inadvertently included into the original IDS table. The applicant too believes these are not relevant to the examination and requests that the references be removed.
4. Drawings. The applicant submits replacement sheets for drawing sheets 1-6 which address the drawing concerns raised by the office. The lines have been made uniformly thick and well defined, the reference characters are at least 1/8 inch in height, and the scale appears to be sufficient in size to allow two-thirds reduction for reproduction.

The office also objected that the claimed "output shaft" was not shown in the drawing sheets. The applicant has deleted the term "output shaft" from the claims making the identification in the drawing sheets moot.

5. Specification. The office raised the concern that the specification did not provide antecedent basis for the term "output shaft". The term "output shaft" is synonymous with the term "crankshaft (8)" used in the specification. The applicant having replaced the term in the claims makes the specification objection moot. The applicant does not waive the right to incorporate the term "output shaft" into the specification, if necessary.

6. Section 112 Concerns. The office raised concerns as to claims 1-3 being indefinite. The applicant has amended claim 1 to provide the proper antecedent basis for “the extending part” by replacing “the” with --an--. The applicant has amended claim 13 to replace the language “said system is retrofit to an existing marine drive” with -- said transmission having said extending part and said stern drive extension housing retrofit to an existing marine drive.--

7. Section 102 Concerns. The office has raised novelty concerns with respect to claims 1-12 as being anticipated by United States Patent No. 6,435,923 to Ferguson (“Ferguson”).

A claim is anticipated only if “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); *MPEP 2131*. “The identical invention must be shown in as complete detail as is contained. . .in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1225, 1236 (Fed. Cir. 1989). Moreover, the elements must be arranged as required by the claim. *En re Bond*, 910 F.2d 831 (Fed.Cir. 1990); *MPEP 2131*. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings”). *MPEP 2111.01 IV*.

The applicant has amended claim 1, element c. as set out below for the convenience of the examiner:

- (c) a stern drive extension housing sealably mounted to each of said transom and a transom assembly mounted to said stern drive unit to enclose exterior of the
~~boat enclosing the an~~ extending part of ~~[[the]]~~ said transmission ~~and extending between the transom and said stern drive~~ between said transom and said transom assembly.

This language is supported by the applicant's specification at Page 6, l. 1-12. The applicant does believe any new matter has been introduced into the claim.

The office indicates that the Ferguson discloses "a stern drive extension housing (62)". Office Action at page 5. This is incorrect. The Ferguson reference discloses a "a second gear housing (62) which is adapted for connection to the forward reverse housing (32). . Housing (62) is adapted to extend through opening (22) of transom (14)." See Ferguson, Col. 4, ll. 58-67 and Col. 5, ll. 1-3. Ferguson further discloses that the "the transom is not capable of carrying any substantial support load. Thus the stern drive unit is effectively isolated from the hull (12) by its support through the engine (18) and engine mounts (20)." Accordingly, as shown by Figure 1 and as described the "second gear housing (62)" passes through the transom but is uncoupled or isolated from the transom.

The "stern drive extension housing" claimed by the applicant is not taught by Ferguson. As described by applicant's specification beginning at page 6, l. 1:

"The transmission and stern drive extension housing 25 is mounted on the outside of the transom 27 of the boat by bolts or fasteners . . . the transom assembly 20 is mounted on the extension housing 25 and the stern drive 10 is mounted to the transom assembly. . ."

See also applicant's Figure 11, which shows an embodiment of the stern drive extension housing 25 bolted to the transom 27.

Accordingly, the applicant's claimed "stern drive extension housing" which is secured by bolts or other fasteners to the transom and by bolts and fasteners to the stern drive to enclose the extending portion of the transmission is not suggest, taught or otherwise disclosed by the Ferguson reference.

Because applicant's "stern drive extension housing" as recited in claim 1 is not taught by Ferguson, claim 1 can be differentiated from and is not anticipated by the Ferguson

reference. Because each of claims 2-10 and 12-13 are ultimately made dependent upon an independent claim which is not anticipated by Ferguson these dependent claims are also not anticipated by the Ferguson reference.

CONCLUSION

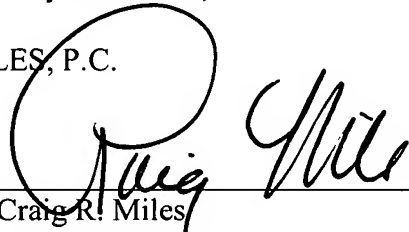
The applicant has canceled claims 11 and 14-24 without prejudice. Substitute drawing sheets have been submitted to overcome the drawing objections, the term "output shaft" has been deleted from the claims to overcome the specification objections, claims 1 and 13 have been amended to overcome the Section 112 concerns, and the applicant has amended claim 1 to differentiate the invention claimed from the Ferguson reference to address the Section 102 concerns of the office. The applicant respectfully request reconsideration of claims 1-10 and 12-13 in view of the amendments and arguments made and allowance of claims.

Dated this 10 day of August, 2007

Respectfully Submitted,

CR MILES, P.C.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Title: Marine Stern Drive and Multi-speed Transmission Propulsion System

Inventor: Aaron C. Mansfield and Jason A. Mansfield

Application Number: 10/825,772

Filing Date: April 15, 2004

Group Art Unit: 3617

Examiner Name: Vasudeva, Ajay

Attorney Docket Number: Mansfield131-04

CERTIFICATE OF EXPRESS MAILING

I, Shannon M. Kammerer, hereby certify to the truth of the following items:

1. I am an employee of CR MILES, P.C., 405 Mason Court, Suite 119, Fort Collins, CO 80524.
2. I have this day deposited the attached Response and Request for Reconsideration Under 37 C.F.R. §1.116 (7 page(s)) with the United States Postal Service as "Express Mail" for mailing to:

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dated this 10 day of August, 2007


Shannon M. Kammerer